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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,256	08/22/2001	Lutz Biedermann	70301/56223	2209

7590 12/13/2002

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EXAMINER .

STEWART, ALVIN J

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,256

Applicant(s)

BIEDERMANN ET AL.

Examiner

Alvin J Stewart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9,13-15,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 10-12 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 13, 15, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Christensen US Patent 5,944,760.

Christensen discloses a prosthetic foot having two concave-shape elements (26 & 120; see Figs. 8, 9, 14 and 15), a tension element (50) and one connecting means (128). The concave-shape elements have a lower leg region, a forward region (22) and a heel region (122). The heel region has a ground surface and the forward region has another ground surface (see col. 6, lines 31-37).

Claims 9 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et al US Patent 5,116,384.

Wilson et al discloses a prosthetic foot having two elements (70 & 28; see Figs. 1 & 2), a tension element (12) and one connecting means (32). The elements have a lower leg region, a forward region (20) and a heel region (16). The heel region has a ground surface and the

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forward region has another ground surface (see Fig. 2). Finally the tension element has a ribbon-like element.

Response to Arguments

Applicant's arguments filed October 21, 2002 have been fully considered but they are not persuasive.

The Examiner agreed with the applicant's comment regarding the difference between the Applicant's invention and the prior art. However, the structure limitations of the prior art clearly read on the structural limitations of the applicant's invention because the independent claim is broad.

Regarding the Applicant's argument in the first paragraph of page 3, the Applicant is only claiming a region (a heel region, a lower region, a forward region, etc.) and is not specifically claiming a member or something alike. For the above reason, the Examiner has found the argument moot.

Regarding the Applicant's argument in the third paragraph of page 3, the Examiner called element 50 a tension element and only interpreted the term "tension element" as a noun in order to identify the structure. The Applicant has to enter new limitations in order to overcome the rejection.

Regarding the Wilson et al reference, the prior art clearly discloses all the structure limitations claimed by claims 9 and 14.

Wilson et al discloses a first spring element (10) extending from a toe region (close to element 58) to a lower leg region (adjacent to element 65); a second spring element (28) extending from a heel region (16) to the lower leg region (52); the spring elements are connected

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to each other at the lower region by element (33). A tension element (14) having two ends (22 & 44); one end (22) is connected to a forward region (22) of the first spring and connected with the other end (44) at the heel region (16) of the second spring element. The structure limitations of the prior art clearly read on the structural limitations of the applicant's invention because the independent claim is broad. Applicant should enter new limitations in order to differentiate the invention.

Regarding claim 14, the Applicant has to enter new limitations in order to clarify the structural limitations of the ribbon-like element. The wavy shape of the tension element (14) disclosed by the Examiner was called a ribbon-like element.

Regarding the clarification of claim 10 by the Applicant, the Examiner has only object to claims 10-12.

For the above reasons, the Examiner has maintained the previous rejection to the independent claim and made this office action final. The Examiner believes that the rejections made to the above claims are proper.

Allowable Subject Matter

Claims 10-12 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


AST

December 6, 2002


CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700